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EXAMINER	
JEAN GILLES, JUDE	

ART UNIT	PAPER NUMBER
2143	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary	Application No.	Applicant(s)	
	10/021,787	HOSOI, EIICHIROH	
	Examiner	Art Unit	
	JUDE J. JEAN GILLES	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-10 and 12-16* is/are rejected.

7)☒ Claim(s) *3 and 11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to the reply filed on 05/22/2008.

Response to Arguments

1. Applicant's arguments with respect to the independent claims have been considered but are moot in view of the new ground(s) of rejection. Mainly Applicant submits that the cited references, and specifically Umanski fail to teach or suggest "a system that takes data that is originally in an electronic mail format, converts that data into an image form and then transmits that electronic mail data converted into said image form to the receiver by facsimile communication procedures". New reference of Umanski in combination with Zong and Ohta teach the invention as claimed.

Allowable Subject Matter

2. Claims 3 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1, 4-9, and 12-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Umansky U.S. Patent No. 7,142,550, in view of Zong, U.S. Pub. No. 2001/0000301 A1.

Umansky teaches a method for communicating electronic mail data from a sender to a receiver via a network (figs. 1 and 5), comprising the steps of:

(a) recognizing a dial number of said receiver corresponding to destination address information attached to said electronic mail data (*abstract; fig. 3; col. 3, lines 1-20; col. 3, lines 13-30*);

(b) converting said electronic mail data into an image form permitting facsimile communication, wherein said electronic mail data originates in an electronic mail format (*see abstract; col. 6, 32-49);*

(c) initiating a call to said receiver using said recognized dial number and transmitting said electronic mail data converted into said image form to the receiver by facsimile communication procedures (*see abstract, col. 3, lines 1-20, col. 6). Although Umansky teaches substantial features of the claimed invention, Umansky does not distinctly teach the step of* (d) converting said electronic mail data converted into said image form back into electronic mail data in the electronic mail format. Nonetheless, this feature is well known in the art, and would have been obvious modification to the system of Umanski as evidenced by Zong.

In an analogous art, Zong discloses a system that comprises " a receiver that receives incoming fax data from a fax machine directly connected to it and converts the fax image into an e-mail message..." (see Zong, par. 0019).

Accordingly, it would have been obvious for an ordinary skill in the art, to have incorporated the system of Umanski with the feature of Zong for the purpose of allowing "a device that will enable a facsimile machine and another device such as personal computer to access a global computer network simultaneously over the same global computer network". See Zong par. 0014). By this rationale, claim 1 is rejected.

Regarding claims 4-9, and 12-16 the combination Umanski-Zong teaches:

4. (Previously presented) An electronic mail communicating method, comprising the steps of:

(a) retrieving mail information stored in a server to be transmitted over a switched line from the server, wherein the mail information originates in an electronic mail format (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30*);

(b) selecting a specification of communication needed for communication over the switched line from a network address contained in said mail information (*see Umanski, abstract, col. 3, 1-20; figs 1, 3, and 5*); and

(c) initiating a call to said switched line using the selected specification of communication, and transmitting said mail information according to facsimile

communication procedures to a receiving apparatus connected via the switched line information (*see Umanski, abstract, col. 3, 1-20; figs 1, 3, and 5; col. 6*); and

(d) forwarding said mail information from the receiving apparatus to the network address according to the electronic mail format (see Umanski abstract; see Zong abstract, and , par. 0019).

5. (Original) The electronic mail communicating method as set forth in claim 4, wherein the step of retrieving comprises the step of retrieving said mail information with recognition that the mail information is to be transmitted from said network address via said switched line (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 6, lines 13-30*).

6. (Currently Amended) An electronic mail communicating method, comprising the steps of:

(a) receiving data containing electronic mail information converted from an electronic mail format into an image form permitting facsimile communication from a sender, wherein said electronic mail information originates in the electronic mail format (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 6, lines 13-30*);

(b) converting said received data into electronic mail information (*seeUmanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 6, lines 13-30*);

(c) analyzing a destination contained in the converted electronic mail information data (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 6, lines 13-30*);

(d) generating reply information to converted electronic mail information (see Zong, 0019);

(e) converting said reply information into said image form and sending the converted reply information to the sender (see Zong, 0019).

7. (Original) The electronic mail communicating method as set forth in claim 6, wherein, if a terminal with a destination corresponding to said analyzed destination is not connected to an internal network, reply information representing absence of any relevant destination is generated.

8. (Original) The electronic mail communicating method as set forth in claim 6, wherein, if received data do not contain electronic mail information, conventional facsimile reception operation takes place. (see *Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 6, lines 13-30*).

9. (Previously presented) An electronic mail transmitting apparatus for transmitting electronic mail data to a receiver using a switched line not through the Internet, comprising:

a communication specification determination unit for determining a specification of communication with said receiver for communication over said switched line based on destination address information for an external network assigned to the electronic mail data (see *Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 6, lines 13-30*);

a conversion unit for converting electronic mail data to be transmitted into a data form for communication over said switched line, wherein said electronic mail data originates in an electronic mail format;

a transmission unit for transmitting said electronic mail data converted into said data form by said converting unit, to said receiver in accordance with said specification of communication determined by said communication specification determination unit, using said switched line;
and

a reconversion unit for converting said electronic mail data converted into said data form that has been received over said switched line into electronic mail data in the electronic mail format (see Zong, 0019).

12. (Previously presented) An electronic mail transmitting apparatus, comprising:

a mail retrieving unit for retrieving from a server mail information to be transmitted over a switched line, wherein said mail information originates in an electronic mail (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30*);

a communication specification determination unit for determining a specification of communication for communication over the switched line based on a network

address contained in said mail information retrieved by said mail retrieving (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30; col. 6*); and

a transmission unit for initiating a call on said switched line using said specification of communication determined by said communication specification determination unit ((*see Umanski; abstract; figs. 1, 3 and 5)* and

transmitting said mail information to a receiving apparatus connected via the switched line by facsimile communication, wherein the receiving apparatus converts the mail information back into the electronic mail format (see Zong; par. 0019).

13. (Previously presented) A mail receiving apparatus for receiving electronic mail data originating in an electronic mail format that has been converted into a form permitting facsimile communication from a sender via a switched line (see Umanski, figs 1, 3, and 5), comprising:

a receiving unit for receiving data from said sender via said switched line by facsimile communication (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30*);

a restoring unit for restoring said data received by said receiving unit into electronic mail data (see *Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 6, lines 13-30*); and

a transferring unit for transferring said electronic mail data restored by said restoring unit to a server connected to an internal network (see Zong; par. 0019).

14. (Original) The electronic mail receiving apparatus, as set forth in claim 13, further comprising: a destination recognition unit for recognizing a destination of the electronic mail data based on said electronic mail data restored by said restoring unit; and a notification unit for notifying the sender if the destination recognized by said destination recognition unit is not in said internal (*see Umanski; abstract; figs. 1, 3 and 5*).

15. (Previously presented) An electronic mail communication system, comprising: an Internet-connected transmission mail server; a transmission client connected to the transmission mail server to instruct transmission of electronic mail, and a transmission agent connected to a switched line to function as a client to the transmission mail server (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30*).

wherein said transmission client outputs, to said transmission mail server, electronic mail data in an electronic mail format that includes a description of a destination of said transmission agent and a description of a final mail destination (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30*); and

wherein said transmission agent retrieves electronic mail data in which the destination of the transmission agent is described by said transmission client from said transmission mail server and transmits the electronic mail data using facsimile communication procedures using the switched line to a receiving apparatus that reconverts the electronic mail data into an electronic mail format (see Zong; par. 0019).

16. (Previously presented) An electronic mail communication system for transmitting and receiving electronic mail information between an internal network on a sender side

and an internal network on a receiver side(*see Umanski; abstract; figs. 1, 3 and 5; see abstract; see col. 3, 1-20*); wherein

the internal network on the sender side comprises a transmission mail server, a transmission client for generating electronic mail information, and a transmission agent which is a client having a function for transmitting the electronic mail information in a facsimile format via a switched line (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30*);

the internal network on the receiver side comprises a reception mail server, a reception client which is a final destination of the electronic mail information, and a reception agent which is a client having a function for receiving the electronic mail information via a switched (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30; col. 6*);

said transmission agent transmits an electronic mail message whose final destination is said reception client designated by said transmission client to said reception agent via said switched line (*see Umanski; abstract; figs. 1, 3 and 5; col. 3, lines 1-20; col. 3, lines 13-30; col. 6*);

said reception agent transfers said electronic mail received via said switched line to said reception mail server in an electronic mail format (see Zong; par. 0019).

4. **Claims 2, and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Umansky and Zong, further in view of Ohta, U.S. Patent No. 6,396,848 B1.

Regarding claim 2, Umansky teaches the method as set forth in claim 1, wherein the step of converting comprises the step of determining a horizontal number of pixels and generating data by linking the data with the horizontal number in a vertical direction according to a specification based on ITU-T Recommendation T-30. Nonetheless this feature is well known and would have been an obvious modification to the system of Umanski and Zong as evidenced by Ohta.

In an analogous art, Ohta teaches "a facsimile communications control program, used by the communications controller 32, for controlling the facsimile communications procedures in accordance with the Group 3 facsimile protocols conforming to the T-30 recommendations of the ITU-T" (see Ohta, column 10, lines 25-32).
Given this feature, a person of ordinary skill in the art would have been readily recognized the desirability and advantages of modifying the system shown by Umansky and Zong with the system of Ohta to allow data terminal writes a facsimile number in a header of E-mail. Thereby, the network facsimile machine can perform relay transmission by designating the destination facsimile terminal using the facsimile number provided..." (see Ohta, column 1, lines 46-52). By this rationale, Claim 2 is rejected.

10. The electronic mail transmitting apparatus as set forth in claim 9, wherein said communication specification determination unit stores in advance correspondence information among destination address information for a network assigned to electronic

mail data, a dial number of said receiver and a communication procedure based on ITU-T Recommendation T-30, and determines the specification of communication based on the stored correspondence information (see Ohta, column 10, lines 25-32).

Conclusion

5. ***This action is made Non-Final.*** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0800.

/Jude J Jean-Gilles/

Examiner, Art Unit 2143

JJG

August 29, 2008